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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,547	03/31/2004	Richard Warren Hailey	014586-9013-00	7402
1131 7590 01/18/2008 MICHAEL BEST & FRIEDRICH LLP Two Prudential Plaza 180 North Stetson Avenue, Suite 2000 CHICAGO, IL 60601			EXAMINER FABER, DAVID	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,547	Applicant(s) HAILEY ET AL.	
	Examiner David Faber	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed on 5 November 2007 and the Information Disclosure Statement filed on 4 January 2008.
2. Claims 1, 14, 15, 16, and 28 have been amended.
3. The objection to the drawings has been withdrawn as necessitated by the submission of the new drawings. The rejection of Claims 1, 12-13, 16-17, and 28-30 under 35 U.S.C. 102(b) as being anticipated by Poole et al (US Patent #6,006,242, patented 12/21/1999) has been withdrawn as necessitated by the amendment. The rejection of Claims 2-6, 7-11, 14-15, 18-22, and 23-27 under 35 U.S.C. 103(a) as being unpatentable over Poole et al in further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452) has been withdrawn as necessitated by the amendment.
4. Claims 1-30 are pending. Claims 1, 14-16, and 28 are independent claims.

Drawings

5. The drawings were received on 5 November 2007. These drawings are accepted.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 4 January is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 16-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 16 and 28 are rejected under 35 U.S.C. 112, 2nd paragraph, since the limitation "creating a transaction data set" fails to relate or coincide with the other limitations with the limitations. In other words, once the transaction data set into is created, what does transaction data set do? What is the transaction data set used for? Since the claim limitation fail to shows these missing functionalities, the Examiner views the claims as vague and indefinite.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Joshi et al (US Patent #7,299,409, filed 3/7/2003).

As per independent claim 1, Joshi et al a method discloses generating a document comprising:

- establishing a software architecture for a set of rules, where each rule in the set of rules is configured to be embedded in one or more computer-processable documents, the documents consisting of a plurality of components, the set of rules defining content to be included in each instance of the one or more computer-processable documents; and (FIG 1, FIG 4, Column 7, line 64 – Column 8, line 24; Claim 1: Discloses a document containing a markup syntax with a reference(rule) embedded in the document, when processed, it executes the referemce of the markup syntax (that defines document content to be included) by retrieving the actual document content (i.e. actual image) to be included in the document, wherein the document contains renderable components such as a body , header and footer, and dynamic content area (slow-loading component) (Column 2, lines 14-19))
- creating a dynamic document structure that resolves to one or more instances of a document and that is configured to include document content including one or more embedded rules based on the software architecture for the set of rules; and resolving, with a computer processor, the dynamic document structure by executing the one or more embedded rules included in the

document content to create a specific instance of a document. (FIG 4, 5; Column 8, line 16 – Column 9, line 32: The dynamic web content is structured by an embedded reference within a markup syntax that defines the document content within the document that when processed or executed, resolves by retrieving the actual document content (i.e. actual image) that is outside of the document and places the content within the document when it is retrieved; therefore resolving an instance of the document by executing the embedded rule included in the document content (reference within the markup syntax)

As per dependent claim 12, Joshi et al discloses a method:

- creating a static document structure that can be resolved into one or more instances of a document that includes at least some content that is determined before and some content that is unchanged during and after a resolution process. (FIG 1, Column 12, lines 10-30: Discloses only a portion of displayable Web content is dynamic wherein therefore the rest of the displayable Web page content remains unchanged or static. Therefore, static content is presented that remains unchanged through a changed process after being determined)

As per dependent claim 13, Joshi et al discloses a method:

- providing a data set (FIG 4) configured to be processable by one or more rules built on the architecture for a set of rules (FIG 4, FIG 5; Column 7, line 64 – Column 8, line 24)

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-6, 7-11, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al (US Patent #7,299,409, filed 3/7/2003) in further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452).

As per dependent claims 2-6, Joshi et al fails to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439), choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Harold et al's

disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user to define custom types.

As per dependent claim 7-11, Joshi et al fails to specifically disclose creating a schema having an external interface element that is configured to be resolved into a value, wherein the value is chosen from a group that includes a set, an XML DOM node, and an XML DOM node list, and wherein the external data interface element is configured to have an entity reference attribute and a return type attribute, and having an internal interface and an external interface element.. However, Harold et al discloses an param element (xsl: param, (receives a value) Page 444; xsl:with-param, (sends a value) p451) that sends/receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171) In addition, the xsl:template provides information how data is used including the received value using xsl:param. (p444-445, 448)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user the ability to retrieve the information from an outside source.

As per independent Claim 14, Claim 14 recites similar limitations as in Claim 1 and is similarly rejected under rationale.

Joshi et al fails to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element, and having an external interface element that is configured to be resolved into a value. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439), choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383). In addition, Harold et al discloses an param element (xsl: param, Page 444; xsl:with-param, p451) that receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes, allowing the user to define custom types and retrieve the information from an outside source.

As per independent Claim 15, Claim 15 recites similar limitations in as in Claim 12 and Claim 14 combined, and is similarly rejected under similar rationale.

Furthermore, the static document structure is resolved when the execution occurs of one or more rules embedded in the document content. (Column 12, lines 10-30)

14. Claims 16-17, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al (US Patent #7,299,409, filed 3/7/2003) in further view of Poole et al (US Patent #6,006,242, patented 12/21/1999)

As per independent claim 16, Claim 16 recites similar limitations as in Claim 1 and is similarly rejected under rationale. Furthermore, Joshi et al discloses retrieving one or more cross-referenced document components from a data base (Col 6, lines 1-2, 19-20; Column 12, lines 10-30: Discloses receiving document from a server wherein the server has access and couple to a storage device (data repository), therefore accesses the storage device of the server when retrieving the content from the server) However, Joshi et al fails to specifically disclose creating a transaction data set, processing the one or more cross-referenced document components in a processor to generate a tree having a root node; processing the tree beginning at the root node, and when a rule is encountered, evaluating the rule and replacing it with a value. However, Poole et al disclose creating a transaction data set; (Column 5, lines 3-7; Column 29, STEP 1: collecting transaction data by instantiating (or create) business objects.), processing the one or more cross-referenced document components in a processor to generate a tree having a root node; processing the tree beginning at the root node; (Column 4, lines 6-16: parsing a document creates a tree wherein inherently a tree is created that contains at least one root node. After parsing and during validating, process inherently starts at

top of the tree at the root and work its way down the tree.) and when a rule is encountered, evaluating the rule and replacing it with a value; (Column 45, lines 18-27: rules are evaluated, and replaces rules with objects presenting a value)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Poole et al's disclosure since it would have provided a document production system that provides for a high degree of content re-use and a flexible inferencing capacity that dynamically determines content to be included in a document.

As per dependent claim 17, Claim 17 recites similar limitations as in Claim 1 and is similarly rejected under rationale.

As per independent claim 28, Claim 28 recites similar limitations as in Claim 16 and is similarly rejected under rationale.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 17 and is similarly rejected under rationale.

As per dependent Claim 30, Claim 30 recites similar limitations as in Claim 28 and is rejected under rationale. Furthermore, Joshi et al fails to specifically disclose disclosing establishing a list of data structures. However, Poole et al discloses establishing a list of data structures. (Column 4, lines 53-56: a collection of documents is a list of documents)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Poole et al's disclosure since it would have provided a document production system that provides for a high

degree of content re-use and a flexible inferencing capacity that dynamically determines content to be included in a document.

15. Claims 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al (US Patent #7,299,409, filed 3/7/2003) in further view of Poole et al (US Patent #6,006,242, patented 12/21/1999) in further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452).

As per dependent claim 18-22, Joshi et al and Poole et al fail to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439), choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al and Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user to define custom types.

As per dependent claim 23-27, Joshi et al and Poole et al fail to specifically disclose creating a schema having an external interface element that is configured to be resolved into a value, wherein the value is chosen from a group that includes a set, an

XML DOM node, and an XML DOM node list, and wherein the external data interface element is configured to have an entity reference attribute and a return type attribute, and having an internal interface and an external interface element.. However, Harold et al discloses an param element (xsl: param, (receives a value) Page 444; xsl:with-param, (sends a value) p451) that sends/receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171) In addition, the xsl:template provides information how data is used including the received value using xsl:param. (p444-445, 448)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al and Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user the ability to retrieve the information from an outside source.

Response to Arguments

16. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Arguments address regarding of the new limitations of Claims 1-30 brought forth in the amendment of establishing a software architecture for a set of rules, where each

rule in the set of rules is configured to be embedded in one or more computer-processable documents, the documents consisting of a plurality of components, the set of rules defining content to be included in each instance of the one or more computer-processable documents; creating a dynamic document structure that resolves to one or more instances of a document and that is configured to include document content including one or more embedded rules based on the software architecture for the set of rules; and resolving, with a computer processor, the dynamic document structure by executing the one or more embedded rules included in the document content to create a specific instance of a document has been viewed the new ground of rejection of 35 USC 102(e) under new references using Joshi et al.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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